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Reply to OA of: May 3, 2007

crystal microbalances, which is contrary to what Applicant's desire to claim in the instant application. Accordingly, because Applicants respectfully submit that there is no error in claim 10, it is respectfully requested that this objection be withdrawn.

Turning now to the rejections set forth in the Official Action, the rejection of claim 10 under 35 U.S.C. §103(a) as being unpatentable over Kawakami et al. (US Pat. No. 5,728,583) in view of Luscher (US Pat. No. 3,585,527) has been carefully considered but is most respectfully traversed in light of the amendments to the claims and the following comments.

Applicants wish to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 707.07(f) wherein it is stated that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

The Official Action urges that Kawakami discloses a connecting station comprising a connecting panel 10. Kawakami further allegedly discloses that the

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connecting panel 10 allegedly has an array of cell connecting receptors 11a-11c, wherein each cell connecting receptor comprises a receptor connector portion. Kawakami further allegedly discloses that the connector portions each comprise a pair of electric connecting ports 72, 73 and a pair of fluid connecting ports 61-61c, 62a-62c.

The Official Action also urges that Kawakami discloses a plurality of piezoelectric crystal microbalance flow-through cells as shown in Figures 2 and 3.

Applicants respectfully traverse the position that Kawakami discloses the elements of claim 10 as alleged in the Official Action. Specifically, Applicants respectfully submit that Kawakami fails to disclose (1) piezoelectric crystal microbalance flow-through cells and (2) a pair of fluid connecting ports in the connector portions of the connecting panel.

With respect to the allegation that Kawakami discloses piezoelectric crystal microbalance flow-through cells (hereinafter "flow-through cells"), the Official Action points to Figures 2 and 3 of the reference. Figure 2 depicts a cross-sectional view of the structure shown in Figure 3 when fully assembled. Applicants note that the bottom of the alleged flow-through cell is the lower member 10. The plate-shaped quartz oscillators 50, the cell compartment seal members 40, the outer seal member 30 and the upper member 20 are then sequentially stacked on top of the lower member 10 to allegedly form flow-through cells.

However, Applicants note that the Official Action also alleges that the lower member 10 corresponds to the connecting panel recited in claim 10 of the instant application. Thus, the Official Action appears to allege that the lower member 10 serves the dual purpose of serving as the connecting panel and the bottom portion of the flow-through cells. Such an interpretation is clearly contrary to what is disclosed and recited in the instant application.

As shown in, e.g., Figures 2 and 3 of the instant application, the flow-through cells of the instant application comprise both a first half 14 and a second half 16. Then, as shown in Figure 8, the flow-through cell 10 comprising a first half and a second half 20 is placed in the cell connecting receptor of the connecting panel 112. The flow through cell and the connecting panel are clearly separate elements. In fact, the

detachability of the flow-through cells depends on the flow through cells having a housing separate of the connecting panel.

Assuming Kawakami is interpreted such that the lower member 10 is the flow-through cell recited in claim 10, then Kawakami fails to disclose a connecting panel as recited in claim 10. Assuming Kawakami is interpreted such that the lower member 10 is the connecting panel recited in claim 10, the Kawakami fails to disclose a flow through cell. The bottom of the alleged flow-through cells would be the plate-shaped quartz oscillators 50. This configuration would clearly fail to disclose a flow-through cell as the term is used in the instant application, because the flow-through cell would not comprise a unit which encases the piezoelectric crystal microbalances.

Therefore, since there is no reasonable interpretation of Kawakami in which the reference may be deemed to disclose a flow-through cell and a connecting panel, where the flow-through cell and the connecting panel are separate elements, Applicants respectfully submit that the Kawakami reference fails to disclose the elements of the claims which the Official Action alleges are disclosed in the reference.

With respect to the allegation that the Kawakami reference discloses cell connecting receptors having receptor connection portions with a pair of electric connecting ports and a pair of fluid connecting ports disposed therein, the Official Action points to reference numerals 11a-11c, 72 and 73 in Figure 6 and reference numerals 61a-61c and 62a-62c in Figure 1. Applicants note that the cell connecting receptors are the circular indentations 11a-11c in the lower member 10 as shown in Figure 6. As also depicted in Figure 6, contacts 72 and 73 are formed in the indentations 11a-11c.

However, what is not depicted in the indentations 11a-11c shown in Figure 6 are a pair of fluid connecting ports. The Official Action points to the tubes 61a-61c and 62a-62c in Figure 1 as disclosing fluid connecting ports in the cell connecting receptors, but as can clearly be seen in Figure 1, the tubes 61 and 62 are connected to the upper member 20. That is to say, no portion of the tubes 61 and 62 are connected with the lower member 10 and the circular indentations 11a-11c interpreted as reading on the cell connecting receptors.

According to the interpretation of Kawakami set forth in the Official Action, the tubes connect with the flow-through cells, since the upper member 20 is the upper

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portion of the flow-through cells. This is contrary to what is clearly claimed in the instant application. As clearly set forth in claim 10, the pair of fluid connecting ports are located within the connector portion, the connector portion being part of the connecting panel.

Thus, contrary to the position taken in the Official Action, Applicants respectfully submit that the Kawakami reference fails to disclose a connector portion with a pair of fluid connecting ports as recited in the claims of the instant application.

The Official Action relies upon the Luscher reference as disclosing that the quartz oscillator of Kawakami would inherently have two electrodes. However, Applicants respectfully submit that the Luscher reference fails to remedy any of the deficiencies identified above with respect to Kawakami. According, because neither Luscher nor Kawakami, either standing alone or when taken in combination, disclose or suggest every element of claim 10, Applicants respectfully submit that a proper §103(a) rejection according to the guidelines set forth in MPEP §2143 has not been established. It is therefore respectfully requested that the §103 rejection of claim 10 over Kawakami and Luscher be withdrawn.

Continuing with the rejection of claim 10 as being obvious over Kawakami, and Luscher, the Official Action expressly acknowledges that these references fail to disclose a plurality of piezoelectric crystal microbalance flow-through cells that are detachable. In order to address this deficiency, the Official Action alleges that constructing a formerly integral structure in various elements involves only routine skill in the art and therefore it would be obvious to make this modification. The Official Action cites *Nerwin v. Erlichman*, 168 USPQ 177, 179 in support of this position.

Applicants begin by noting that there are two issues here, and it is unclear which the Official Action is addressing via the citation to *Nerwin*. Firstly, Kawakami fails to disclose a detachable flow-through cells and secondly, Kawakami fails to disclose individual flow-through cells. The citation to *Nerwin* appears to address the issue of the separating the integral flow-through cells shown in Kawakami to result in individual flow-through cells, but Applicants respectfully submit that the cited case law has no effect whatsoever on whether the flow-through cells would be detachable. As shown in Figure 9, a clamp 90 is used to hold the lower member 10 and the upper member 30 together.

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Thus, even if the flow-through cells are individual flow-through cells, the clamp 90 will still make the upper member 30 non-detachable from the lower member 10.

Turning now to the cited case law, Applicants respectfully submit that no portion of *Nerwin*, a copy of which is submitted herewith, appears to stand for the proposition that constructing a formerly integral structure in various elements involves only routine skill in the art. In fact, the term "routine skill in the art" is not found in any portion of the decision. Rather, the relevant portion of *Nerwin* merely states that "[t]he mere fact that a given structure is integral does not preclude its consisting of various elements." No conclusion as to whether converting something that is integral into various elements only requires routine skill in the art, thus rendering such a modification obvious. Accordingly, Applicants respectfully submit that the cited case does not properly support the position advanced in the Official Action.

Moreover, Applicants note that the issue in *Nerwin* was directed to whether a specification provided support for an amendment to the claims. In discussing that an integral structure may consist of various elements, the Board made the point that the integral structure could provide support for two different element in the claims because the integral structure consisted of various elements. Accordingly, Applicants respectfully submit that this case is quite irrelevant to the issue at hand, since *Nerwin* is directed to questions of whether there is support in a specification for claims amendments, while the present issue is related to whether a proposed modification is obvious. *Nerwin* in now way discusses the standard of obviousness, and therefore, as stated above, does not properly support the position advanced in the Official Action.

In light of the above discussion, Applicants respectfully submit that neither the cited references nor the cited case law disclose or suggest every element of claim 10, and therefore a proper §103 rejection according to the guidelines set forth in MPEP §2143 has not been established. Applicants therefore respectfully request that the §103 rejection of claim 10 over Kawakami, Luscher and the cited case law be withdrawn.

The rejection of claims 11-13 under 35 U.S.C. §103(a) as being unpatentable over Kawakami in view Luscher and Takeuchi et al. (US Pat. No. 6,326,563) and the rejection of claim 14 under 35 U.S.C. §103(a) as being unpatentable over Kawakami in view of Luscher and Ricchio et al. (US Pat. No. 5,130,095) have each been carefully

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considered but are most respectfully traversed in light of the amendments to the claims and the following comments.

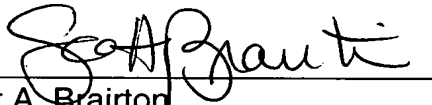
Applicants note that claims 11-14 each depend from claim 10 and are therefore patentable over Kawakami and Luscher for the same reasons as provided above with respect to the §103(a) rejection of claim 10. Furthermore, Applicants respectfully submit that neither Takeuchi nor Ricchio disclose or suggest those features of claim 10 which Kawakami and Luscher fail to disclose. Accordingly, as none of the prior art references, either standing alone or when taken in combination, disclose or suggest each and every element of claim 10, Applicants respectfully submit that claim 10 and all claims depending therefrom, including claims 11-14, are patentable over the references of record. Applicants therefore respectfully request that the §103(a) rejections of claims 11-14 be withdrawn.

The provisional obviousness-type double patenting rejection of claims 10, 12 and 13 as being unpatentable over claims 2-47 of co-pending Application No. 10/539,065 in view of Kawakami and the provisional obviousness-type double patenting rejection of claims 14 as being unpatentable over claims 2-47 of co-pending Application No. 10/539,065 in view of Kawakami and Ricchio have each been carefully considered. Because these double-patenting rejections are provisional double-patenting rejections, Applicants respectfully request that they be held in abeyance until the only issue remaining in the instant application is the provisional obviousness-type double patenting rejections or the co-pending application issues as a patent. See MPEP §804.I.B.

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In view of the above comments, favorable reconsideration and allowance of all the claims now present in the application are most respectfully requested.

Respectfully submitted,  
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August 3, 2007

**Particular patents—Accelerometer**

5,540,678, Gottzein, Klamka, Bittner, Schwake, Method of and Apparatus Controlling the Transverse Acceleration Roll Damping of Steerable Aerodynamic lies, claims 1, 2, 6, 7, and 10 of application refused.

**Appeal from Group 221.**

Application for patent of Eveline Gottmann, Norbert Klamka, Helmut Bittner, and Hermann Schwake, Serial No. 662,435, filed Aug. 22, 1967. From decision rejecting claims 1, 2, 6, 7, and 10, applicants appeal (No. 925-38). Affirmed.

GLEW & TOREN, New York, N. Y., attorneys for applicants.

Core KREEK, KEELY, and STRADER, Examiners in Chief.

KEELY, Examiner in Chief.

This is an appeal from the final rejection of claims 1 through 10, all the claims in the case. Subsequent to the appeal, the examiner withdrew his rejection of claims 3, 4, 8 and 9. Accordingly, the appeal as to these claims is dismissed leaving for our decision claims 1, 2, 6, 7 and 10.

The references relied upon by the examiner are:

Harris, Jr. et al. 2,873,074 Feb. 10, 1959

Miller et al. 3,007,656 Nov. 7, 1961

We have reviewed the present disclosure of the claims in the light of the examiner's appellants' comments and as a result of our review find that the disputed claims do not patentably distinguish over the prior art.

It was noted in our review of the present disclosure that it lacks both hardware and circuitry necessary to meet the requirements of 35 U.S.C. 112 and its dependent Rule of the Rules of Practice.

Appellants have not described the circuit hardware of the individual geometric forms shown in the Figures of the drawing, the circuit interconnections between these various forms, or where in patents, publications or specific commercial devices one will find elements that will function in geometric forms.

Turning now to the method claim 1, it is noted that it recites two manipulative steps, the first of which, except for the term "roll", is found in Harris et al., and both of which appear to be present in Miller et al. We attach no patentable significance to the term "dirigible" since in its broad sense

means "steerable" which is definitive of the Miller et al. device.

We also note that this claim is drawn so broadly as to include gyroscopic type accelerometers.

The other method claims are likewise deemed to find response in the references.

[1] Claims 6, 7 and 10 use the term "comprising" to introduce the claimed structure, which means to us that the device covered by these claims may involve many more elements than those positively recited therein, for example, many gyroscopes.

The structure positively recited in the claims finds response in either reference. The term "sole" used in the claims is not a structural limitation, but is in the nature of a negative limitation.

Accordingly, we will sustain the prior art rejection of these claims.

As pointed out above, appellants have disclosed no structural support for the apparatus claims 6, 7 and 10.

The device described in the specification and shown in the drawing covers any kind of accelerometer, any type of a control loop, any kind of actuator elements and any kind of a signal processing network. Each of these elements, mechanical or electrical, are different in structure and operation, require different interconnections and produce different results.

In the absence of a specific identification or description of each of the aforesaid elements the routineer is not taught how to practice the invention, workers in the art have no knowledge as how to proceed with future developments in the art without infringing the claims and courts lack any knowledge as to what they are dealing with in interpreting the claims.

[2] The pertinent case law requires appellants to disclose apparatus for practicing the method where, as in this case, the apparatus is not obvious to a routineer.

Accordingly, we reject claims 1, 2, 6, 7 and 10 for lack of disclosure, 35 U.S.C. 112, under the provisions of Rule 196(b).

We make no comments with respect to allowed claims 3, 4, 5, 8 and 9 in the light of *Watson v. Bruns*, 99 U.S. App. D.C. 327, 239 F.2d 948, 1957 C.D. 51, 714 O.G. 4, 111 USPQ 325.

The decision of the examiner is affirmed.

A new rejection is made under the provisions of Rule 196(b).

Any request for rehearing or reconsideration or modification of this decision by the Board of Appeals based upon the same record must be filed within thirty days from the date of the decision. (Rule 197). Should

appellants elect to have further prosecution before the examiner in response to the new rejection under Rule 196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire *thirty days* from the date of this decision.

**Patent Office Board of Patent Interferences**

NERWIN V. ERLICHMAN

Decided May 29, 1969

**PATENTS**

**1. Interference — Interference in fact (\$41.40)**

**Interference — Issues determined (\$41.45)**

Since interference party in opposition to opponents' motion to amend by adding counts did not raise issue of no interference in fact because of improper modification of patent claims in counts, that issue as raised for first time in party's brief will not be considered; had party raised issue before primary examiner in opposing motion, either opponent or examiner might have cited prior art to show lack of patentable distinction between patent claims and counts.

**2. Interference — Interference in fact (\$41.40)**

Demonstration by mere comparison that patent claim and count consisting of broadened modification of patent claim recite distinct or different inventions in sense of *Brailsford v. Lavet*, 138 USPQ 28, is not determinative of issue as to whether patent claim and count are directed to same invention; upon such demonstration there would remain the question whether in view of pertinent prior art the substance of count makes obvious to one ordinarily skilled in the art the substance of patent claim, or vice versa.

**3. Interference — Issues determined (\$41.45)**

Issues of lack of support for counts are not considered where they were raised for first time in briefs at final hearing.



#### 4. Patentability — Divided and integral parts (§51.35)

Fact that a structure is integral does not preclude its consisting of various elements.

Patent interference No. 95,697 between Nerwin and Erlichman. Priority awarded to Erlichman.

Before BOYS and CAPELLI, Examiners of Interferences, and ROEMING, Acting Examiner of Interferences.

ROEMING, Acting Examiner of Interferences.

The counts of this interference relate to a non-camera photographic apparatus and also to a camera.

The interference involves the reissue application of the senior party Erlichman and the patent of the junior party Nerwin. Counts 1 through 5 are claims of the Nerwin patent; counts 6 through 12 are modified claims of the patent.

The specification and drawings of the Erlichman reissue application are identical with those of the patent proposed to be reissued.

No testimony was taken. Only Erlichman filed preliminary statements. Nerwin timely moved to dissolve as to the original count on the ground of lack of support in Erlichman's disclosure. Erlichman opposed. Erlichman moved to amend by adding counts. Nerwin opposed the addition only on the ground of lack of support in Erlichman's disclosure. The Primary Examiner denied the motion to dissolve and granted in part the motion to amend. Nerwin requested final hearing for review of the issues raised by his motion to dissolve and his opposition to the motion to amend.

[1] Since Nerwin in his opposition to Erlichman's motion to amend did not raise the issue of no interference in fact because of improper modification of the patent claims in counts 6 through 12, that issue as raised for the first time in Nerwin's brief at final hearing will not be here considered. As to

[2] whether or not a patent claim and a count consisting of a broadened modification of the patent claim are directed to the same invention, it would not be determinative of the issue to demonstrate by mere comparison that the count and the patent claim recite distinct or different inventions in the sense of *Brailsford v. Lavet et al.*, 50 CCPA 1367, 318 F.2d 942, 796 O.G. 311, 1963 C.D. 723, 138 USPQ 28. Upon such demonstration there would remain the ques-

tion whether or not in view of pertinent prior art the substance of the count makes obvious to one ordinarily skilled in the art the substance of the patent claim, or *vice versa*. Had Nerwin raised the issue of no interference in fact before the Primary Examiner in opposing the motion to amend, either Erlichman or the Primary Examiner might have, if necessary, cited prior art to show lack of *patentable distinction* between the patent claims and the respective counts. See *In re Wagenhorst*, 20 CCPA 829, 62 F.2d 831, 431 O.G. 532, 1933 C.D. 173, 16 USPQ 126; *In re Hidy*, 49 CCPA 1152, 303 F.2d 954, 782 O.G. 16, 1962 C.D. 380, 133 USPQ 650; *In re Ellis et al.*, 47 F.2d 963, 409 O.G. 559, 1931 C.D. 330, 8 USPQ 489, and *In re Risse et al.*, 54 CCPA 1495, 378 F.2d 948, 154 USPQ 1. Since neither Erlichman nor the Primary Examiner had the opportunity to cite prior art on this issue when Erlichman moved to add the counts which became counts 6 through 12, the issue of no interference in fact as now belatedly presented is not shown to be completely developed. Accordingly, any consideration of it here would be pointless.

[3] The only issues here to be determined are those specific issues of alleged Erlichman lack of count support which were raised by Nerwin before the Primary Examiner on the parties' motions, namely in Papers Nos. 8, 13 and 14 of the interference file. Those specific issues of lack of support raised for the first time in Nerwin's briefs at final hearing will not be here considered. *Smith et al. v. Klemperer* (Board of Interference Examiners 1949), 103 USPQ 275, and the court cases therein cited.

As to count 1, at page 1 of his reply brief Nerwin admits that the use limitations in the preamble are supported by Erlichman's Figure 10.

In issue is Erlichman's right to make in count 1 the limitations (1) "a divider between said exposure and processing chamber" and (2) "means effective upon movement of said strip along said first path for denoting the leading edge of each said sheet along a second path branching from said first path \* \* \* into said exposure chamber."

Nerwin in effect contends that these limitations set forth two separate elements, that he discloses a divider comprising the roller 44 and the wall 34, that in his disclosure "the directing means comprises strip-per 43," that in Erlichman's disclosure of Figure 10 these limitations find support only in the structure 198, that that structure is a single element, and that Erlichman "may not use this single element to meet two

whether or not in view of pertinent prior art the substance of the count makes obvious one ordinarily skilled in the art the substance of the patent claim, or *vice versa*. And Nerwin raised the issue of no interference in fact before the Primary Examiner in posing the motion to amend, either Erlichman or the Primary Examiner might, if necessary, cited prior art to show lack of *patentable distinction* between the patent claims and the respective counts. See *In re Wagenhorst*, 20 CCPA 829, 62 F.2d 431, 431 O.G. 532, 1933 C.D. 173, 16 USPQ 126; *In re Hidy*, 49 CCPA 1152, 13 F.2d 954, 782 O.G. 16, 1962 C.D. 380, 13 USPQ 650; *In re Ellis et al.*, 47 F.2d 43, 409 O.G. 559, 1931 C.D. 330, 8 USPQ 489, and *In re Risse et al.*, 54 CCPA 195, 378 F.2d 948, 154 USPQ 1. Since neither Erlichman nor the Primary Examiner had the opportunity to cite prior art on this issue when Erlichman moved to add the counts which became counts 6 through 12, the issue of no interference in fact as now belatedly presented is not shown to be completely developed. Accordingly, any consideration of it here would be pointless.

[3] The only issues here to be determined are those specific issues of alleged Erlichman lack of count support which were raised by Nerwin before the Primary Examiner on the parties' motions, namely in papers Nos. 8, 13 and 14 of the interference proceedings. Those specific issues of lack of support raised for the first time in Nerwin's briefs at the final hearing will not be here considered. *In re Smith et al. v. Klemperer* (Board of Interference Examiners 1949), 103 USPQ 275, and the court cases therein cited.

As to count 1, at page 1 of his reply brief Nerwin admits that the use limitations in the preamble are supported by Erlichman's figure 10.

In issue is Erlichman's right to make in count 1 the limitations (1) "a divider between said exposure and processing chamber" and (2) "means effective upon movement of said strip along said first path for denoting the leading edge of each said sheet along a second path branching from said first path \*\*\* into said exposure chamber."

Nerwin in effect contends that these limitations set forth two separate elements, that he discloses a divider comprising the roller 44 and the wall 34, that in his disclosure "the directing means comprises stripper 43," that in Erlichman's disclosure of figure 10 these limitations find support only in the structure 198, that that structure is a single element, and that Erlichman "may not use this single element to meet two

positively stated and separately claimed elements of the count." Erlichman cites *In re Kelley*, 49 CCPA 1259, 305 F.2d 909, 785 O.G. 413, 1962 C.D. 681, 134 USPQ 397, as authority that said limitations are properly supported by his structure 198. He further asserts and Nerwin does not deny that these limitations are unambiguous. Erlichman correctly notes that in Nerwin's patent the roller 44 is not only the divider but is also part of the "means \*\*\* for pressing said layers toward one another." Nerwin's specification states as to his element 43:

"\*\*\* To assist in directing the free end of the sheets into the exposure chamber a thin *stripper* member 43 of resilient material may be provided, so arranged as to bear lightly against the roll of film material in the supply chamber \*\*\*" [Emphasis added.]

The emphasized terms in the foregoing statement indicate that the stripper member 43 is not per se the entire means for "directing" the sheet into the exposure chamber. The roller 44 clearly participates also in that function. Nerwin states:

"\*\*\* In Figure 10 of the Erlichman disclosure, the only structure conceivably forming such a divider is guide member 198. How guide member 198 functions as a divider is not clear since there is essentially a direct path from exposure chamber 184 to processing chamber 196 of Erlichman \*\*\*"

Neither Nerwin nor Erlichman uses the term "divider" or expressly refers to a dividing function in his specification. In any event, it is clear that the tip of Erlichman's member 198 interposes itself between the strip and the sheet in the same manner as does Nerwin's roller 44, thus to divide the paths of the strip and the sheet.

[4] The mere fact that a given structure is integral does not preclude its consisting of various elements. In *Howard et al. v. Detroit Stove Works*, 150 U.S. 164, 65 O.G. 1765, 1893 C.D. 659, the Supreme Court pertinently stated:

"\*\*\* the Monumental grate \*\*\* contains all the *elements* of the Beckwith grate, except that \*\*\* it is cast in two pieces, while the Beckwith grate is cast in one piece." [Emphasis added.]

In *Reed v. Edwards*, 26 CCPA 901, 101 F.2d 550, 505 O.G. 234, 1939 C.D. 291, 40 USPQ 620, the court stated:

"\*\*\* with reference to the statement [of the Board of Appeals] that the same element may be relied upon for perform-

ing two functions, we express no opinion thereon with respect to the application of that rule as applied to the counts before us. We are of the opinion, however, that while a given structure may in one sense be considered a single element, in another sense it may be so formed as to consist of several elements depending upon the functions to be performed by such elements."

If the upper portion of Erlichman's member 198 were eliminated and the "divider" tip of member 198 were supported by a member extending horizontally directly to the outer wall of chamber 196, then after the dividing of the paths of the sheet and of the strip, the sheet would not be guided into the exposure chamber 184. Clearly the upper portion of Erlichman's member 198 is an element which performs a function distinct from the dividing function of the tip, namely the function of assisting in guiding the sheet into the exposure chamber. Moreover, as Erlichman correctly points out, the curved surface joining the wall 188 of his exposure chamber and the top wall of his supply chamber cooperates in bending and guiding the sheet into the exposure chamber. We find it unnecessary to rely on *In re Kelley*, supra. In analogy to the findings in *Reed v. Edwards*, supra, and *Holsworth v. Goldsmith*, 29 CCPA 1047, 129 F.2d 571, 542 O.G. 791, 1942 C.D. 491, 54 USPQ 90, we find that Erlichman supports the above indicated limitations of count 1 without double reading on the same element or structure. Moreover, we find that for support of these limitations Erlichman relies on "double reading" no more than does Nerwin.

Also in issue is Erlichman's right to make in count 1 the limitation: "said divider being effective upon continued movement of said strip \*\*\* to cause such sheet to be effectively pulled \*\*\* back past said divider and through said processing chamber in inverted position on said strip with said photosensitive and image-receptive layers facing one another." Nerwin contends that in Erlichman, the "inversion takes place in the initial movement of the strip by which the photosensitive sheet 164 branches into exposure chamber 184." When Erlichman's sheet is located in the exposure chamber there clearly is no completed inversion of the sheet, and the photosensitive and image-receptive layers do not face one another. On the continued movement of the strip, the sheet is clearly pulled back past the divider, the inversion is completed, and the said layers are brought into position to face one another.